Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOSEPH PEISERT

Appeal No. 2003-1615
Application 09/274,639

ON BRIEF

Before KRATZ, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9 and 12-20. On page 6 of the answer, the examiner has indicated that claims 6 and 16-18 are allowed.

Claims 1 and 7 are representative of the subject matter on appeal and are set forth below:

1. A pollution control device, comprising:

(a) a housing;

(b) a pollution control element positioned within the

housing, the pollution control element having an inlet, an outlet, and a face; and

(c) a sheet of mounting material having opposing mating edges, the sheet of mounting material positioned around a majority of the face of the pollution control element between the pollution control element and the housing such that at least a portion of the mating edges meet to form a seam that is at a non-perpendicular angle to the inlet and the outlet of the pollution control element, the seam extends from a point near the inlet to a point near the outlet of the pollution control element, and the sheet of mounting material is capable of being adjusted to variations in the circumference of the element by moving the mating edges in opposing directions until the sheet of mounting material fits tightly about the face of the pollution control element to prevent exhaust gases from flowing between the pollution control element and housing.

7. A mounting mat for wrapping a pollution control element of a pollution control device, the mat comprising a sheet of mounting material having opposing lateral edges substantially parallel to each other, and opposing end edges substantially parallel to each other, and each of the opposing end edges being at a non-perpendicular angle to the lateral edges, wherein the mat has a surface area sufficient to cover and protect the pollution control element from shock and vibration damage.

The references relied upon by the examiner are:

Foster et al. (Foster)	4,239,733	Dec. 16, 1980
Merry	4,929,429	May 29, 1990
Corn	5,332,609	July 26, 1994

Claims 9 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1-5, 7-9, 12-15 and 19-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Merry or Corn in view of Foster.

OPINION

For the reasons set forth below, we reverse each of the rejections.

I. The 35 U.S.C. § 112, second paragraph, rejection

On page 3 of the answer, with regard to claim 9 (and claim 13 because claim 13 depends upon claim 9), the examiner states "it is unclear as to what structural limitation applicant is attempting to recite and where it is shown in the drawings. Where the gap or space is shown in the drawings, and how the gap or space is related at all to the sheet as it appears that the sheet by itself does not contain any gap or space therebetween."

We note that the purpose of the second paragraph of Section 112 is to basically ensure, with a reasonable degree of particularity, an adequate notification of the metes and bounds of what is being claimed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

The examiner's position (as quoted above) does not address whether or not appellant's claims 9 and 13 provide for an adequate notification of the metes and bounds of what is being claimed. In fact, it appears that the examiner's position is directed to the first paragraph of Section 112.[1]

We also note that the examiner bears the initial burden of presenting a prima facie case of unpatentability, whether

[1] The first paragraph of Section 112 concerns whether the original disclosure reasonably conveys to one of ordinary skill in the art that, as of the time of the filing of the present application, the inventors had possession of the subject matter as now claimed. In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). In other words, the query is whether the concept is present in the original disclosure. In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). This issue is not before us.

the rejection is based on prior art or any other ground. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We emphasize that the query under 35 U.S.C. § 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Here, the examiner has not explained how claims 9 and 13 are deficient in this regard. We therefore reverse the rejection.

II. The 35 U.S.C. § 103 rejection

We refer to pages 3-6 of the answer regarding the examiner's position of obviousness.

We note that the initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d at 1445, 24 USPQ at 1444 (Fed. Cir. 1992). Where an obviousness determination is based on a combination of prior art references, there must be some "teaching, suggestion or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "[T[he factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It is impermissible to conclude that an invention is obvious based solely on what the examiner considers to be basic knowledge or common sense. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus, the burden is on the examiner to identify concrete evidence in the record to support his conclusion that it would have been obvious to modify the teachings of the cited references to achieve the claimed invention. See

id.; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In the present case, the examiner has simply failed to meet this aforementioned burden for the following reasons.

In the rejection, the examiner states "[s]ince both methods to form the seam of the mounting sheets were art-recognized equivalents at the time the invention was made in insulating and supporting the catalytic converter within the casing, one of ordinary skill in the art would have found it obvious to substitute one type of seam of Foster et al for the other type of seam of either Merry or Corn for the known and expected results of obtaining the same results in the absence of unexpected results." Answer, pages 4-5.

However, we do not observe, and the examiner has not pointed out, where in the cited art is it taught that the seam depicted in Foster's Figure 2 is an art recognized equivalent of the seam of Merry or Corn. We find this especially critical in view of the fact that the mounting material 46 of Foster is used in a different context as compared with the context in which the mounting material is used in Corn or Merry. That is, as pointed out by appellant in both the brief and reply brief, Foster's sleeve is not positioned around the majority of the face of the pollution control element, and in fact is used in conjunction with wire mesh sleeve 44, and cylindrical protrusions 62 and 64, to form a sealing system. Brief, pages 18-19 and reply brief, pages 7-8. We conclude, therefore, that the examiner's conclusion of "art-recognized equivalents" is not supported by the facts before us.

Furthermore, we observe that appellant's specification, on page 7, at lines 9-20, indicates that end edges 16, 18 of mounting material 10 are at a non-perpendicular angle to the

lateral edges 12, 14. Claim 7, for example, recites that "the mat comprises a sheet of mounting material having opposing lateral edges substantially parallel to each other, and opposing end edges substantially parallel to each other, and each of the opposing end edges being at a non-perpendicular angle to the lateral edges." The examiner has not pointed to any disclosure in the applied art that teaches a sheet of mounting material having such a configuration.

For at least the reasons discussed above, we reverse the obviousness rejection.

III. Conclusion

The 35 U.S.C. § 112, second paragraph, rejection is reversed.

The 35 U.S.C. § 103 rejection is reversed.

REVERSED

Peter F. Kratz Administrative Patent Judge	)	
Jeffrey T. Smith Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Beverly A. Pawlikowski Administrative Patent Judge	)	

BAP/cam

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